



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/521,305

01/14/2005

Toru Ishibashi

CFO17416WOUS

9351

34904

7590

08/18/2009

CANON U.S.A. INC. INTELLECTUAL PROPERTY DIVISION

15975 ALTON PARKWAY

IRVINE, CA 92618-3731

EXAMINER

BHAT, NARAYAN KAMESHWAR

ART UNIT

PAPER NUMBER

1634

MAIL DATE

DELIVERY MODE

08/18/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

<b>Application No.</b> 10/521,305	<b>Applicant(s)</b> ISHIBASHI ET AL.
<b>Examiner</b> NARAYAN K. BHAT	<b>Art Unit</b> 1634

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: None.  
Claim(s) objected to: None.  
Claim(s) rejected: 1-24.  
Claim(s) withdrawn from consideration: 1-13.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/JD Schultz/  
Supervisory Patent Examiner, Art Unit 1635

Continuation of 11. does NOT place the application in condition for allowance because claims 14-16 and 19-24 have been rejected as being unpatentable over Iwaki et al in view of Duran et al. Claims 14, 16, 17 and 18 have been rejected as being unpatentable over Iwaki et al, Duran et al and McGovern et al. Claims 14, 24, 25 and 26 have been rejected as being unpatentable over Iwaki et al, Duran et al and Allain et al. The proposed claim amendments after the final action will be entered. Applicant's arguments filed on July 16, 2009 with respect to teachings of cited references are not persuasive for the following reasons.

Claim rejections 35 USC103 (a):

Applicants argue that claims 14 and 24 as amended requiring the subject matter of cancelled claims 25 and 26 is not obvious over the teachings of Iwaki et al and Duran et al (Remarks, pgs. 8 and 9). This argument is not persuasive because as described in the final office action in section 11, amended claims 14 and 24 requiring the subject matter of cancelled claims 25 and 26 have been rejected over Iwaki et al, Duran et al and Allain et al. Applicant's arguments attacking references individually when the rejections are made using combination of references are not persuasive because courts have ruled that Applicant's arguments by attacking references individually are not persuasive wherein the rejections are based on combinations of references (See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)). In the instant case, as described in the final office action in section 11, Iwaki et al, Duran et al and Allain et al teaches the method steps as recited in amended claims 14 and 24 and therefore arguments are not persuasive.

With respect to claims 14 and 16-18, Applicants further argue that McGovern et al do not cure the deficiencies of Iwaki et al and Duran et al (Remarks, pgs. 9 and 10). These arguments are not persuasive because arguments are based on the amended claim 14 incorporating the subject matter of now cancelled claim 25. These newly added limitations were not present at the time of the final rejection. However, it is noted that the subject matter of amended claims 14 and 16-18 are deemed obvious over Iwaki et al, Duran et al, McGovern et al and Allain et al. For these reasons arguments are not persuasive.

With respect to claims 14, 24, 25 and 26, Applicants further argue that Allain et al do not cure the deficiencies of Iwaki et al and Duran et al (Remarks, pgs. 10 -13). This argument is not persuasive because as described in the final office action in section 11, Iwaki et al teaches imparting probes to the immobilization substrate using a "ink jet system" (paragraph 0067). Allain et al explicitly teaches method for imparting a plurality of probes to the immobilization substrate using a nozzle, which is instantaneously heated to eject the solvent containing the probe and allowing the solvent to fly (Fig. 1a, pg. 147, Thermal printer and Array spotting section, pg. 148, Results and discussion section, paragraph 1, lines 1-20) for providing an inexpensive, rapid and reliable method for delivering small sample volume to the printing surface with outstanding reproducibility (pg. 146, column 2 and paragraph 2).

Applicants further argue that Allain does not teach imparting a 'probe having a mercapto functional group' to an immobilization substrate using 'a nozzle that is instantaneously heated' (Remarks, pg. 11, paragraph 2). This argument is not persuasive because claims have been rejected using combination of references of Iwaki et al, Duran et al and Allain et al. As described above, Applicants arguments attacking references individually are not persuasive when the claims are rejected using combination of references. As described above and in the final office action, Iwaki et al, Duran et al and Allain et al teaches method steps of amended claims 14 and 24, including probe having mercapto functional groups and therefore arguments are not persuasive.

Applicants remaining arguments regarding teachings of Allain et al are directed to biological sample and hybridization (Remarks, pg. 11, paragraph 3), which are not persuasive because they do not commensurate with the scope of the claims.

Applicants further argue that additional steps are needed in the method of Allain et al to secure the DNA sample to the substrate (Remarks, pg. 12, paragraph 2). This argument is not persuasive because as described above, Iwaki et al teaches probe deposition using ink jet system and Allain et al provides teaching, suggestions and motivation to use ink jet system with thermal print head in the method of Iwaki et al.

Applicant's argument regarding claim 24 are directed to Iwaki et al, Duran et al and Allain et al not teaching the subject matter of claim 26 (Remarks, pg. 12, paragraph 3). These arguments are similar to the one made for claim 14 and are not persuasive for the same reasons as described above.